
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: MATHIES, Richard A., et al.

Attorney Docket No.:

UCALP20/ B03-085

Issued Patent No.: 7,445,926

Examiner: BEISNER, WILLIAM H

Issue Date: November 4, 2008

Group: 1797

Title: FLUID CONTROL STRUCTURES IN
MICROFLUIDIC DEVICES

Confirmation: 5540

CERTIFICATE OF EFS-WEB TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through EFS-WEB to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on December 30, 2008.

Signed: /Latonia Ervin/
Latonia Ervin

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705(d)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Issuance of the above-captioned patent on November 4, 2008, and in accordance with 37 C.F.R. §1.705 (d), Applicants respectfully request reconsideration of the period of adjustment. Specifically, Applicants respectfully submits that the current USPTO patent term adjustment of 643 days should be increased to 1213 days under 35 USC § 154(b)(1)(B) and 37 C.F.R. §§1.702(b) and §1.703(b) based on failure to issue the patent within three years of the actual filing date of the application in view of the decision in *Wyeth v. Dudas*, District Court of Columbia (D.D.C. 2008).

Statement of Fact, as Required by §1.705

The Applicant respectfully submits that the current USPTO patent term adjustment of 643 days should be increased to 1213 days to account for a one-day term extension for every day greater than three years after the filing date that it takes for the patent to issue under 35 USC § 154(b)(1)(B) and 37 C.F.R. §§1.702(b) and §1.703(b) in view of the decision in *Wyeth*.

Under *Wyeth*, the proper formula for determining PTA is: delay under 35 USC § 154(b)(1)(A) ("A" delay) plus delay under 35 USC § 154(b)(1)(B) ("B" delay) less (any part of "A" delay that overlaps with "B" delay) less applicant's delay. Under *Wyeth*, "[t]he

only way that [A and B] periods of time can ‘overlap’ is if they occur on the same day.” (*Id.* at 8).

Using the *Wyeth* manner of calculating PTA, the subject application was filed December 29, 2003, giving the PTO until February 28, 2005 to issue the first Office Action. Applicants received a Restriction Requirement on March 7, 2007, leaving the “A” delay to be 737 days. The “B” delay is then determined by taking the issue date, November 4, 2008, and subtracting it from the three-year date, December 29, 2006, for an additional 676 days of PTA. The PTO “A” and “B” delays total 1413 days. There is no overlap between the “A” delay and the “B” delay under *Wyeth*.

When the Applicants’ delays are considered, the PTA becomes 1213 days. Applicants acquired 94 days of delay resulting from extension requests and 106 days from a delayed IDS filing (calculating the time between the Response to Office Action filed on January 14, 2008 and the subsequent IDS filed on April 29, 2008). The PTA days of 1412 are then reduced by Applicants’ delay of 200 days, leaving a new PTA of 1213 days.

This petition is timely submitted under §1.705(d) within two months of the date the patent issued. Applicants submit that the above issue could not have been raised under §1.705(b) prior to or with payment of the issue fee on September 2, 2008. This is because the issue date used to calculate the “B” delay above was unknown at that time and because prior to the *Wyeth* decision on September 30, 2008, the PTO’s interpretation of 37 CFR §1.705(f) precluded Applicants from obtaining patent term extension for both the “A” and the “B” delays, as described above. (“Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)” 69 Fed. Reg. 34238). Since the issue fee was paid prior to the *Wyeth* decision, which changed the application of the relevant CFR sections, Applicants submit that the above issue could not have been raised under §1.705(b).

This patent application is not subject to terminal disclaimer. Applicants submit that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination.

In view of the foregoing, it is respectfully submitted that the Applicants should be granted an additional 570 days of PTA. The Commissioner is hereby authorized to charge the fee for filing a request for reconsideration of the patent term adjustment pursuant to §1.705 set forth in §1.18(e) of \$200.00 and any other fees which may be required or credit any overpayment to Deposit Account No. 504480 (Order No. UCALP020)

Applicants respectfully request that the patent term adjustment be reconsidered.

Respectfully submitted,
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